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| 09/656,013 | 09/07/2000 | Russel Dale Cole | SP1042 | 2278 |

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EXAMINER

HEWITT, JAMES M

| ART UNIT | PAPER NUMBER |
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3679

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/656,013
Filing Date: 9/7/00
Appellant(s): COLE, RUSSELL

Joseph McGlynn
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/23/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The amendment after final rejection filed on 1/23/03 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 7-8 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 9-10 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|-------|---------|
| 2,068,909 | ENGEL | 1-1937 |
| 4,785,562 | GOOD | 11-1988 |

(10) Grounds of Rejection

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engel (US 2,068,909) in view of Good (US 4,785,562). This rejection is based on the following findings:

Findings

1). Engel discloses a picture frame comprising the combination of a holder (pocket shown in Figures 5 and 6) and an object (5) with corner edges (see page 2, col.1 lines 43-45).

2). Engel's holder includes at least three distinct material layers (30, 10, and 20/40).

3). Engel's holder comprises a corner pocket to engage a corner edge of the object to be held (see title, Figure 3, Figures 5-6 and column 2 lines 40-55).

4). Engel's first layer (30) has a non-slip surface (like layer 3 in Figure 1, layer 30 is gummed on both sides; see page 1, col. 2 lines 23-28) to engage and bear against a corner surface of the object (5) to be held (see page 1, col. 2 lines 40-50). The upper gummed surface corresponds to appellant's non-slip surface.

5). Engel's second layer (10) has adhesive material (like layer 1, layer 10 is gummed on both sides; see page 1, col.2 lines 23-25 and lines 53-55).

6). Engel's third layer (20/40) consists of a transparent material shaped to form with said first layer the corner pocket (see page 1, col. 2 lines 23-55, page 2, col. 1 lines 40-45 and Figures 5 and 6).

7). Engel's object (5) has corner edges to complement the size and shape of the corner pocket formed (see page 1, col. 1 lines 1-8, Figure 3, and Figures 5-6).

8). Engel discloses a supporting surface (6) for the holder.

9). Engel's second layer being directly against and held to the supporting surface (6) by adhesive material.

10). Good discloses a picture frame having a corner piece for supporting an object.

11). The Good frame has a magnetic layer (80) attached to a frame or a frame piece in any suitable manner (see col. 2 lines 44-46).

12). Good teaches the use of the magnetic layer to allow the frame to be attached to a metal surface such as a refrigerator door (col. 2 lines 10-13).

As to claims 7 and 9, Engel discloses all of the limitations of the claimed invention as set forth in findings 1-9 except for the use of a magnetic layer. As set forth in findings 10-12, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Engel's second layer with a magnetic layer in order to permit Engel's picture frame to be attached to a metal surface.

Claims 8 and 10 stand or fall together with claims 7 and 9 respectively.

(11) Response to Argument

Referring to Good, Appellant asserts "There simply is no suggestion that these magnets can be used in corner pocket for the corner edge of an object to be held.", relying upon a recent decision by the CAFC in the case of *In re Lee* (61 USPQ 2nd 1431). The Examiner disagrees. Engel's device is a picture frame comprising corner pockets for retaining and securing a corner edge of a picture to a supporting surface.

Engel uses adhesive to secure the pocket to the supporting surface (e.g. a picture mount). Good secures a picture frame, or corner pieces (see Figure 4) of a picture frame, via magnets to a supporting surface. Both Engel and Good disclose corner pieces which frame a picture on a supporting surface. Engel uses adhesive, a common and widely used fastening means, to secure his corner pieces. Good uses a magnet, another common and widely used fastening means, to secure his corner pieces. The motivation or suggestion to modify Engel by Good to use magnets as a means of securement in place of adhesive is evident as magnets would (1) permit Engel's picture frame to be attached to a metal surface (2) permit quicker attachment and detachment of Engel's device to a supporting surface and (3) avoid the residue common to adhesives. To summarize, Engel discloses the claimed invention except for the fastening means used to secure his device to a support surface. Good uses magnets to secure his device to a support surface. In view of Good's teaching and the advantages of using magnets over adhesive, one having ordinary skill in the art at the time the invention was made would have found it obvious to use magnets to secure Engel's device to a supporting surface instead of adhesive.

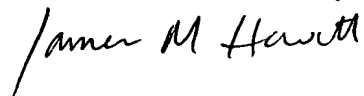
In response to Appellant's assertion "Having magnets used to hold a frame to a supporting surface is not the same as using magnets or magnetic material in a corner pocket that engages the corner edge of the object to be held.", Appellant should refer to the preceding paragraph.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



jmh
April 3, 2003

Conferees
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